

REMARKS

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1, 2, 7, 9, 13, 14, 16, and 20 have been amended as shown on pages 2-5 of the Reply. No new matter has been added.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-20 Under 35 U.S.C. § 101

Claims 1-20 stand rejected under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reason. The subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Independent claim 1 recites: *[a] system that facilitates free form digital inking, the system is recorded on a computer-readable medium and capable of execution by a computer*, comprising: *an annotation management component* that generates an inking region for a digital document; and *a navigation component* that enables manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region.

The claimed subject matter relates to a system that can facilitate free form digital inking, wherein the *system is recorded on a computer-readable medium and capable of execution by a computer*. The claimed subject matter includes components, such as an annotation management component and a navigation component, which can facilitate free form digital inking associated with documents (e.g., digital documents). The claimed subject matter therefore includes functional descriptive material, rendering it structurally and functionally interrelated to a computer processor, and thus the subject claims are directed to statutory subject matter. The examiner's attention is respectfully directed to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" issued on October 26, 2005. Annex IV of the guidelines is particularly instructive. Annex IV explains that "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component." As also explained in Annex IV, "[w]hen functional descriptive material

is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”

Further, independent claim 14 recites: *A computer-implemented method that provides a zoom window to annotate digital documents with digital ink*, comprising: generating the zoom window; scaling contents displayed in the zoom window; enabling manual and automatic re-positioning and re-sizing of the zoom window relative to at least one digital document, the re-positioning and re-sizing of the zoom window occurs prior to, concurrently with and after annotation of the at least one digital document as a function of an amount of annotation information displayed in the inking region; positioning the zoom window over an area of interest; and navigating the zoom window after annotating the at least one digital document.

The claimed subject matter facilitates providing a zoom window to facilitate annotating digital documents with digital ink. Further, the claimed subject matter can be implemented by a computer. The claimed subject matter is therefore directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Furthermore, for at least reasons similar to the reasons stated with regard to independent claim 1, independent claim 20 is directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Moreover, independent claims 1, 14 and 20 (and associated dependent claims) recite statutory subject matter as they produce a useful, concrete, and tangible result such to be classified as patentable subject matter according to 35 U.S.C. § 101.

In view of at least the foregoing, it is readily apparent that the subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is requested.

II. **Rejection of Claims 1-2, 4-16, and 18-20 Under 35 U.S.C. §103(a)**

Claims 1-2, 4-16, and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Price *et al.* (US Pub. No. 2001/0043716) (hereinafter “Price *et al.*”) in view of Nagae (U.S. Pat. No. 6,230,169) (hereinafter “Nagae”). Withdrawal of this rejection is respectfully requested for at least the following reason. Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element set forth in the subject claims. To reject claims under 35 U.S.C. § 103(a),

the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. See MPEP § 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed subject matter relates to systems and methods that can facilitate annotating digital documents (*e.g.*, word processing documents, images, *etc.*) displayed devices (*e.g.*, desktop computers, Tablet personal computers (PCs), personal digital assistants (PDAs), cellular phones, and the like). In one aspect, the claimed subject matter can provide a focus plus context-based interface that can enable multi-scale navigation during document annotation. The interface can zoom a region of an underlying document, wherein a user can enter annotations in the region at a size comfortable to the user and suitably scaled to the device display.

In particular, independent claim 1 recites: ***a navigation component that enables manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region***. Price *et al.* and Nagae, either alone or in combination, do not teach or suggest the distinctive aspect of the claimed subject matter.

Rather, Price *et al.* relates to a system and method that enables free-form digital ink annotation of data traces and storage management of the data trace based upon the free-form digital ink annotations. (See Abstract; p. 2, ¶ [0029].) Price *et al.*, teaches a system that can automatically select regions in the data trace based upon the position of the annotation and automatically summarize the data traces, and manage the storage of the data of a data trace based upon the freeform digital ink annotations. (See p. 2, ¶¶ [0028]-[0029].)

However, unlike the claimed subject matter, Price *et al.* fails to teach re-positioning and/or re-sizing an inking region prior to, concurrently with, and after annotation of the digital document based on an amount of annotation information displayed in the inking region. Instead, Price *et al.* discloses that the user may be provided with control over the scale of the display of a data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital ink annotation. (See Abstract; p. 2, ¶ [0033].) Thus, Price *et al.* simply teaches that the user can manually control the scale of the display of the data trace. Further, Price *et al.* fails to teach that re-positioning and/or re-sizing an inking region concurrently with annotation of a digital document.

Further, Nagae fails to cure the aforementioned deficiencies of Price *et al.* with regard to the claimed subject matter. Instead, Nagae teaches an annotation display function that enables a user to check the contents of annotations while reading the text by reducing or enlarging the display image of an annotation input window with a specified magnification in displaying annotations and by superposing the displayed image in a specified position on the text display image on a text display screen. (See col. 1, lns. 42-49.) However, Nagae fails to teach re-positioning and/or re-sizing a region prior to, concurrently with, and after annotation of a document based on the amount of annotation information displayed in the region. Rather, Nagae teaches changing the display magnification of a display image of the annotation based on a specified magnification that can be a system-specified magnification (e.g., default magnification) that can be prepared beforehand or a user-specified magnification. (See col. 2, lns. 21-37.) Nagae also teaches that an annotation input window that is of a fixed size when the user has opened the window on the screen, and the screen can be enlarged or reduced to the size determined by its bottom right end position and its top left end position, when the user moves the window's bottom right end with a pen. (See col. 6, ln.67 – col. 7, ln. 5.)

In contrast, the claimed subject matter can facilitate free form digital inking associated with digital documents, which can facilitate annotation of digital documents. In one aspect, the claimed subject matter can create an inking region that can be utilized to facilitate annotating the digital document. The claimed subject matter can *re-position and re-size an inking region* associated with a digital document *prior to, concurrently with and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region*. For example, as a user is entering annotation information in the inking region, the inking region can be re-sized and/or re-positioned, as desired, based in part on the amount of annotation information being received and/or displayed in the inking region. To continue with the example, if the inking region, as currently sized, is full or close to becoming full (e.g., a portion of the annotation information is near the edge of the inking region), the inking region can automatically increase in size (e.g., create space in the inking region) and/or can be re-positioned to facilitate displaying additional annotation information as such information is received and displayed.

Further, independent claim 14 (and similarly independent claim 20), as amended, recites: enabling manual and automatic re-positioning and re-sizing of the zoom window relative to at least one digital document, *the re-positioning and re-sizing of the zoom window occurs prior to, concurrently with and after annotation of the at least one digital document as a function of an amount of annotation information displayed in the inking region*; positioning the zoom window over an area of interest; and navigating the zoom window after annotating the at least one digital document.

For at least reasons similar to the reasons stated with regard to independent claim 1, Price *et al.* and Nagae, either alone or in combination, do not disclose, teach, or suggest the distinctive aspects of the claimed subject matter.

In view of at least the foregoing, it is readily apparent that Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in independent claims 1, 14, and 20 (and associated dependent claims 2, 4-13, 15, 16, 18, and 19). Accordingly, it is believed that the subject claims are in condition for allowance, and the rejection should be withdrawn.

III. **Rejection of Claims 3 and 17 Under 35 U.S.C. § 103(a)**

Claims 3 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price *et al.* in view of Nagae and N.O. Bouvin *et al.*, “Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards”, **Proceedings of the 11th international conference on World Wide Web**, May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter “Bouvin *et al.*”). Claim 3 depends from independent claim 1; and claim 17 depends from independent claim 14. Bouvin *et al.* fails to cure the aforementioned deficiencies of Price *et al.* and Nagae with regard to independent claims 1 and 14. Based at least on the foregoing reasons, withdrawal of the rejection is respectfully requested.

Further, claim 3 (and similarly claim 17) recites: *the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document*. Price *et al.* Nagae, and Bouvin *et al.*, either alone or in combination, fail to teach or suggest such distinctive feature of the claimed subject matter.

The Examiner states that Price *et al.* and Nagae fail to teach that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document. (See Office Action dated January 10, 2008, p. 23, Ins. 5-7.) Further, Bouvin *et al.* fails to teach the distinctive feature of the claimed subject matter. Rather, Bouvin *et al.* teaches animated opening/closing and a “push down” technique that gradually reveals a gloss while lines below the gloss are pushed down to make room. However, unlike the claimed subject matter, Bouvin *et al.* fails to teach an inking region that appears to grow out of a digital document.

In view of at least the foregoing, it is readily apparent that Price *et al.*, Nagae, and Bouvin, *et al.*, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in claims 3 and 17. Accordingly, it is respectfully requested that the rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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